

YAHOO! INC.,

Opposer,  
- versus -

IPC 14-2007-00091

Opposition to:  
TM Application No. 4-2005-009220  
(Filing Date: 16 Sept. 2005)

ALASKA MILK CORPORATION,  
Respondent-Applicant

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TM: "ALASKA YAMOO"  
Decision No. 2007-133

## DECISION

This is an opposition to the registration of the mark "ALASKA YAMOO!" bearing Application No. 4-2005-009220 filed on September 16, 2005 for the goods "milk" and "milk" products" under Classes 29 and 35 of the International Classification of goods which application was published for opposition on December 15, 2006.

The Opposer in the instant opposition is "YAHOO! INC.," a foreign corporation duly organized and existing under the laws of the State of Delaware, United of America, with principal office at 701 First Avenue, Sunnyvale, California 94089, U.S.A.

On the other hand, the Respondent-Applicant is "ALASKA MILK CORPORATION" with address at Ground Floor, Corinthian Plaza Building, Paseo de Roxas Avenue, Makati City.

The grounds for the opposition are follows:

"1. Yahoo! Inc., ("Opposer" or "Yahoo!"), believes that as the registered owner of the well-known trademark "YAHOO!", the registration in the name of the Respondent-Applicant of the subject mark: (a) will damage and prejudice the rights and interest of the Opposer herein; and, (b) is contrary to the express provision of the Republic Act No. 8293 or the Intellectual Property Code of the Philippines ("IP CODE") in regard to what trademarks may or may not be registered; therefore, Opposer objects to the registration of the subject mark upon the following legal grounds:

a. Section 147.1 of the Intellectual Property Code, which pertains to the exclusive rights of the owner of a registered trademark;

Section 147. The owner of a registered mark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs or containers for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use, of an identical sign for identical goods or services, a likelihood of confusion shall be presumed.

b. Section 147.2 and related sections 123.1 (d), 123.1 (e) and 123.1 (f) of the Intellectual property Code of the Philippines (IP Code). Which Relates to Opposer's rights as owner of an earlier registered trademark and as owner of a well-known trademark;

### Sec. 123. Registrability-

#### 123.1. A mark cannot be registered if it:

(d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:

- (i) The same goods or services, or
- (ii) Closely related goods or services, or
- (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion;

- (e) Is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: *Provided*, that in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;
- (f) Is identical with, or confusingly similar to, or constitute a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark: *Provided further*, That the interest of the owner of the registered mark are likely to be damaged by such use;

c. Section 168.1 of the Intellectual Property Code of the Philippines (IP Code).

Section 168.1. – A person who has identical in the mind of the public the goods he manufactures or deals in, his business or services from those of others, whether or not a registered mark is employed, has a property right inn the goodwill of the said goods, business or services so identified, which will be protected in the same manner as other property rights.

c. Section 165 of the Intellectual Property Code of the Philippines (IP Code)

“Section 165. *Trade names or Business names.*-

Section 165.1. - A name or designation may not be used as a trade name if by its nature or the use or which such name or designation may be put, it is contrary to public order or morals and if, in particular, it is liable to deceive trade circles or the public as to the nature of the enterprise identified by that name.

Section 165.2. (a) Notwithstanding any laws or regulations providing for any obligation to register trade names, such names shall be protected, even prior to or without registration, against any unlawful act committed by third parties: (b) In particular, any subsequent use of the trade name by a third party, whether as a trade name or a mark or collective mark, or any such use of a similar trade name or mark, likely to mislead the public, shall be deemed unlawful.”

Section 165.3. The remedies provided for in Section 153 to 156 and Sections 166 and 167 shall apply *mutatis mutandis*.

Section 165.4. Any change in the ownership of a trade name shall be made with the transfer of the enterprise or part thereof identical by that name. The provision Subsection 149.2 to 149.4 shall apply *mutatis mutandis*.

The only issued to be resolved in the instant opposition is:

WHETHER OR NOT THE TRADEMARK “ALASKA YAMOO”  
APPLIED FOR BY RESPONDENT-APPLICANT IS CONFUSINGLY  
SIMILAR WITH THE TRADEMARK OF THE OPPOSER.

The applicable provision of the law is, Section 123 (d) of Republic Act No. 8293, otherwise known as the Intellectual property Code of the Philippines, which provides:

Sec. 123. *Registrability* – 123.1. *A mark cannot be registered if it:*

- (e) Is identical with a registered mark belonging to a different proprietor or mark with an earlier filing or priority date, in respect of:
  - a. the same goods or services, or
  - b. Closely related goods or services, or
  - c. If it nearly resembles such a mark as to be likely to deceive or cause confusion;

The trademark of the Opposer consist of the word “YAHOO!” while that of the Respondent-Applicant consists of the words “ALASKA YAMOO!”.

The competing trademarks are reproduced below for comparison and proper appreciation.



To be noted in this particular case is the fact the Respondent-Applicant's mark is a composite one. It is composed of many components and one of them is the word “YAMOO!” and this is the very reason why Opposer filed its opposition contending that it is confusingly similar with its mark “YAHOO!”

Records will show that the Opposer's mark “YAHOO!” has been registered with the Intellectual Property Philippines (IPP). The certificates of registration are as follows:

1. Registration No. : 4-1996-110029 (Exhibit “A”)  
Mark : YAHOO!  
Issued on : February 24, 2005  
Goods : books regarding computers networks and searching and retrieving information, sites and other resources on computer networks.  
Class : 16
2. Registration No. : 4-1996-110030 (Exhibit “B”)  
Mark : YAHOO!

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|----|------------------|---|---|
|    | Issued on        | : | February 24, 2005   |
|    | Goods            | : | Promoting the goods and services of others<br>By placing advertisements in electronic sites<br>accessed through computer network. |
|    | Class            | : | 35  |
| 3. | Registration No. | : | 4-1996-110031 (Exhibit "C")   |
|    | Mark             | : | YAHOO!  |
|    | Issued on        | : | February 24, 2005   |
|    | Goods            | : | Computer services   |
|    | Class            | : | 42  |
| 4. | Registration No. | : | 4-1998-000952 (Exhibit "D")   |
|    | Mark             | : | YAHOO!  |
|    | Issued on        | : | February 24, 2005   |
|    | Goods            | : | Communication services  |
|    | Class            | : | 38  |

On the other hand, the Respondent-Applicant trademark application for the mark "ALASKA YANOO!" subject of the instant opposition is covering the goods "milk" under class 29 and "milk products advertising" under class 35 of the international classification of goods

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|----|------------------|---|-------------------------------------|
| 1. | Registration No. | : | 4-1995-103970                       |
|    | Mark             | : | ALASKA & DEVICE                     |
|    | Issued on        | : | November 15, 1995                   |
|    | Goods            | : | Evaporated filled milk, powder milk |
|    | Class            | : | 38                                  |
| 2. | Registration No. | : | 4-2003-006515                       |
|    | Mark             | : | ALASKA EVAPORADA                    |
|    | Goods            | : | All purpose liquid cream            |
|    | Class            | : | 29                                  |
| 3. | Registration No. | : | 4-2003-006516                       |
|    | Mark             | : | ALASKA CONDENSADA                   |
|    | Goods            | : | Sweetened condensed milk            |
|    | Class            | : | 29                                  |

A practical approach to the problem of similarity is to go into the whole of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of prospective buyer. The trademark complained of should be compared and contrasted with the purchaser's memory (not in juxtaposition) of the trademark said to be infringed. (87 C.J.S pp. 288-291) Some such factors as sound, appearance, form, styles, shape, size or format; color. Ideas connoted by the marks; the meaning, spelling and pronunciation of words used; and the setting in which the words appears may be considered. (87 C.J.S. pp 291-292). For indeed, trademark infringement is a form of unfair competition (Clarke vs. Manila Candy Co., Phil. 100, 106: Co Tiong Sa vs. Director of Patents, 95 Phil. 1, 4)

Confusion is likely between trademarks only if their over-all presentation in any of the particulars of sound, appearance, or meaning are such as would lead the purchasing public into believing that the products to which the marks are applied emanated from the same source.

In the case "MEAD Johnson & Co., vs. N.V.J. Van Dorp., Ltd., (7 SCRA 769) [G.R. No. L-17501] April 27, 1963 the Supreme Court ruled, thus:

“In determining whether the two trademarks are confusingly similar, the test is not simply to take their words and compare the spelling and pronunciation of said words. Rather it is to consider the two in their entirety as they appear in their respective labels, in relation to the goods to which they are attached; the discerning eye of the observer must focus not only on the predominant words, but also on other features appearing on the labels.

It is true that between Petitioner’s trademark “ALACTA” and Respondent’s “ALASKA” there are similarities in spelling, appearance and sound, for both are composed of six letters of three syllables each and each syllables has the same vowel, we find the following dissimilarities in the two marks: (a) The sizes of the goods of the petitioner differ from those of the respondent; (b) The colors too differ; and (c) Petitioner’s mark “ALACTA” has only the first letter capitalized and is written in black. Respondent’s mark “ALASKA” has all the letters capitalized written except that of the condensed full cream milk which is red.

Also in the Petitioner’s certificate of registration, the goods fall under class 6 (medicines and pharmaceutical preparation). On the other hand, Respondent’s goods cover milk products, dairy products and infant foods.”

In the case at bar, the dissimilarities between the Respondent-Applicant’s mark and that of the Opposer’s mark are very obvious, such following:

1. The respondent-Applicant’s mark is preceded by the word “ALASKA” while that of the Opposer’s mark is not accompanied by any word or symbol;
2. The word “YAMOO!” in Respondent-Applicant’s mark is different in spelling and pronunciation with that of the Opposer’s mark “YAHOO!”
3. “YAHOO!” in the Opposer’s mark contained letter “H” and written in all capital letter, while the Respondent-Applicant’s mark contained the letter “M” and written all in small letter except the letter “Y”.

As previously pointed out, “YAMOO!”, one of the components of the Respondent-Applicant’s mark is preceded by the word “ALASKA” which has been already known to be related to “milk” for quite a long period of time. This is the very word itself that attracts the buyers or purchasers most particularly the children who are “chocolate or milk” loving creatures.

It is likewise worthy to note that the melodic tone in the radio advertisements of the tagline or the phrase “SA SUSTANSYA’T LASA, WALA PA RING TATALO SA ALASKA” was too touching to the ears most specially to the last tone of the word “ALASKA”.

Another point of attraction which accompanied the mark “ALASKA YAMOO!” in the packaging/labels, which may be a distinction features from the Opposer’s mark are the presents of the two mascots, the cow and a man. ([http://www.alaskamilk.com.ph/prod\\_rtd.php](http://www.alaskamilk.com.ph/prod_rtd.php) page 2 of 2)

A trademark has been generally defined as any word, name, symbol or device adopted and used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured and sold by others. (Societe Des Produits Nestle, S.A. vs. Court of Appeals [356 SCRA 207, 214] 2001)

Whether a trademark causes confusion and is likely to deceive the public hinges on “colorable imitation” which has been defined as such similarity in form, content, words, sound, meaning, special arrangement or general appearance of the trademark or trade name in their

over-all presentation on in their essential and substantive and distinctive parts as would likely mislead or confused persons in the ordinary course of purchasing the genuine article.

In the present case and applying the dominancy test of which the dominant feature of the Respondent-Applicant's mark is the word "ALASKA" which has been known and popular for several years already for "milk", the Bureau of Legal Affairs finds that the Opposer's mark "YAHOO!" will not result in likelihood of confusion with that of the Respondent-Applicant's mark "ALASKA YAMOO!".

WHEREFORE, in light of all the foregoing, the Opposition is, as it is hereby, DENIED. Consequently, trademark Application No. 4-2005-009220 for the mark "ALASKA YAMOO!" filed by Alaska Milk Corporation on September 16, 2005 is hereby GIVEN DUE COURSE.

Let the filewrappers of the trademark "ALASKA YAMOO!" subject matter of this case together with a copy of this DECISION be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 26 September 2007

ESTRELLITA BELTRAN-ABELARDO  
Director, Bureau of Legal Affairs  
Intellectual Property Office